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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ROBERT, EDUARDO C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,199

Applicant(s)

TRIEU ET AL.

Examiner

Eduardo C. Robert

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 78-97 is/are pending in the application.
- 4a) Of the above claim(s) 8-32, 34, 36, 37, 85, 86 and 89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 33, 35, 38, 78-84, 87, 88 and 90-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

In response to applicant's argument that claims 8, 9, 12-14, 37, 85-86, and 89 read on the elected Species I, i.e. Figure 1, because the implant of Figure 1 can have the characteristics recited in the above mention claims, it is noted that the description for the embodiment shown in Figure 1 does not disclose the characteristics of the claims above mention. Also, an implant as the one of Figure 1 with the particular characteristic clearly would constitute a different Species than the one shown in Figure 1. Thus, applicant's argument are not persuasive and the requirement is made FINAL.

Claims 8-32, 34, 36, 37, 85, 86, and 89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention and Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 13, 2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 33, 35, 38, 78-84, 87, 88, and 90-97, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Steffee (U.S. Patent 4,790,303).

Steffee discloses a system comprising an implant with first and second ends, and two anchors (see Figure 5 below). The system further comprises a device 24. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Steffee which has the ability of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Also, with regard to the phrases "adapted for" it has been held that the recitation that an element is "adapted for" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In the instant case the system of Steffee has the ability to perform the function recited in the claims if one so desire.

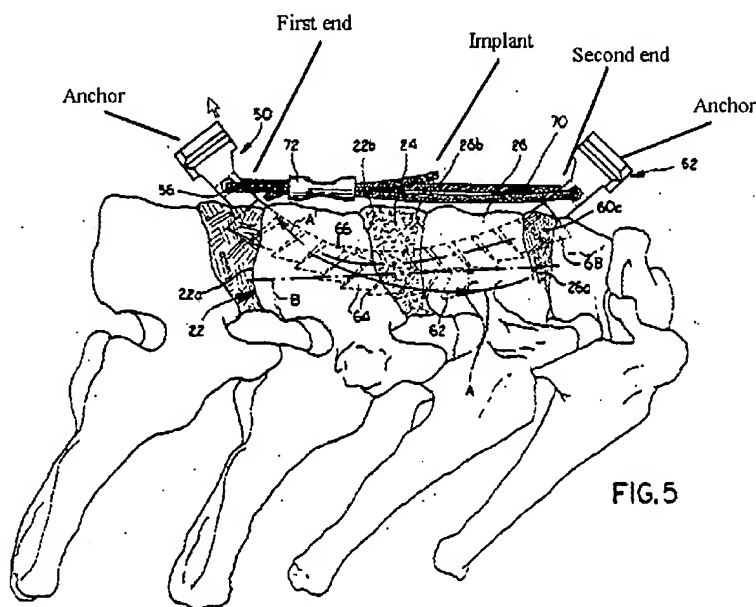


FIG. 5

Response to Arguments

Applicant's arguments filed on March 14, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Steffee does not disclose the arrangement of elements of the system claimed in claim 1, it is noted that Steffee clearly disclose an implant with a first end and an opposite second end (see Figure 5 above) and at least one anchor (see Figure 5 above). What is considered to be the "second end" clearly has a structure has the ability to be positioned in a tunnel of a bone if one so desire. With regard to the functional language "for positioning when in use in a tunnel formed in a first vertebral body" and "for attaching said at least a portion of said one of said first and second ends of said implant to the first vertebral body when positioned in the tunnel with said implant extending extradiscally to a second vertebral body", it is noted that the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to applicant's argument that Steffee does not disclose an implant positioned in a tunnel formed in a second vertebra, it is noted that claim 2 requires only that the at least one anchor is embeddable in the tunnel and the anchor of Steffee is clearly "embedable", capable of being embedded, in a bone tunnel. With regard that the orientation of the implant in the tunnels, it is noted that this was not found in the claims. With regard to the attachment of the ends of the implant to the anchor, it is noted that Figure 5 above clearly shows the ends of the implant attached to anchors. With regard to the position of the anchor along the end of the implant, it is clearly shown in Figure 5 above.

In response to applicant's argument that Steffee does not disclose the arrangement of the elements of the system of claim 78, it is noted that Steffee clearly disclose an implant having a first end and an opposite second end, and at least one anchor. With regard to the functional language "positionable in a tunnel formed in a first vertebral body", it is noted that the first and second end have the ability to be positioned in a tunnel formed in a vertebral body if one so desire. Moreover, with regard to the functional language "for attaching said one of said first and second ends of a said implant to the first vertebral body, wherein when in the tunnel said one of said first and second ends of said implant extends along an angle relative to an axial plane of the spinal column in the range of about 0 degrees to about 80 degrees", it is noted that the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to applicant's argument about claims 79-84, 87, 88, and 90, it is noted that this arguments are not persuasive since it unclear to which claims the limitations are directed. However, the structural limitations of claims 79-84, 87, 88, and 90 are anticipated as set forth in the rejection above.

In response to applicant's argument that Steffee does not disclose the arrangement of the elements of the system of claim 91, it is noted that Steffee clearly disclose an implant having a flexible conformable body extending between a first end and a second end (see Figure 5 above), and at least one anchor engageable, i.e. capable of being engaged, with a vertebral body. With regard to the with regard to the phrases "adapted for", it has been held that the recitation that an element is "adapted for" perform a function is not a positive limitation but only requires the

ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In the instant case, at least a portion of the first and second ends has the ability to be positioned into a tunnel formed in a vertebral body if one so desire. The at least one anchor is engageable, i.e. capable being engaged, to a vertebral body if one so desire. Actually the anchors, in Figure 5, are engaging vertebral bodies. With regard to the functional language "for attaching respective end of the implant", it is noted that the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicant's arguments about claims 92-97, see the remarks above with regard claims 79-84, 87, 88, and 90.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

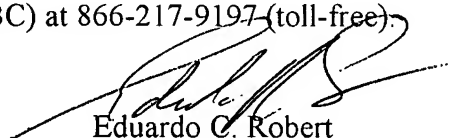
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.